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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,173	01/20/2004	Leighton Randolph Spadone	DN2004008	2079

27280 7590 10/10/2006

THE GOODYEAR TIRE & RUBBER COMPANY
INTELLECTUAL PROPERTY DEPARTMENT 823
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EXAMINER	
RONESI, VICKEY M	
ART UNIT	**PAPER NUMBER**
1714	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/761,173	SPADONE ET AL.	
	Examiner	Art Unit	
	Vickey Ronesi	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *6-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-12* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 January 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/6/04, 4/29/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: mixtures containing Category (C) carbon black and mixtures containing Category (D) carbon black. The species are independent or distinct because they are not used together in the same rubber composition, and they are not obvious variants of each other.

2. Claims 1-12 are generic to a plurality of disclosed patentably distinct species comprising mixtures containing Category (C) carbon black and mixtures containing Category (D) carbon black. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

3. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. During a telephone conversation with Henry Young on 9/27/2006 a provisional election was made with traverse to prosecute the invention of Category (C) carbon black, claims 1-5, 11, and 12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

7. On the IDS dated 4/29/2005, US 5,798,405 has been struck from the IDS because it was already cited on IDS dated 4/6/2004.

Drawings

8. The drawings are objected to because it requires a label of "Figure 1." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." Each drawing sheet submitted after the filing date of an application must be labeled

in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

9. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

- BACKGROUND OF THE INVENTION
  - Field of the Invention
  - Description of Related Art
- BRIEF SUMMARY OF THE INVENTION
- BRIEF DESCRIPTION OF THE DRAWINGS
- DETAILED DESCRIPTION OF THE INVENTION

Each of the above items should appear in upper case, without underlining or bold type, as a section heading.

10. The specification is objected to for not having proper subject headings. In particular, note the "BRIEF DESCRIPTION OF THE DRAWINGS" section. "When there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter)." 37 CFR 1.74.

Claim Objections

11. Claims 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-5, 11, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, there are several issues relating to indefiniteness.

- The phrase in line 1 of the claim "at least one component" causes confusion because the remaining text of the claim suggests that there are no less than 2 components (i.e., tire tread component and component other than a tire tread, wherein each of these components contains a distinct rubber composition). If these components are to be claimed in the alternative, such must be made clear. Confusion arises from line 32 of the claim with conjunctive language "and." In the interest of compact prosecution, the claims are being interpreted as in the alternative.

- In regards to Category (B), it is not made clear if Category (B) necessarily contains both (B-1) and (B-2) or if they are intended to be claimed in the alternative. The specification suggests they are used in the alternative, however, conjunctive language "and" in line 13 suggests otherwise.

- The term "said tire component" in line 23 lacks antecedent basis.

- The term "said carbon blacks" in lines 24 and 35 causes confusion because it is not made clear if the term refers to "particulate carbon black" (line 4) or "Categories of carbon black" (line 7).

With respect to claims 2-5, 11, and 12, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1, 2, 4, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midorikawa et al (JP 08-188672) in view of Sandstrom et al (US 6,220,323).

Pending a full English-language translation of Midorikawa et al, in setting forth this rejection, a machine translation has been relied upon.

Midorikawa et al discloses a rubber composition for a tread in a pneumatic tire comprising 100 phr diene rubber (paragraph 0006); 3-50 phr acetylene black which inherently has the properties of Category (B-2) because Category (B-2) is acetylene black (paragraph 0007); and 10-65 phr carbon black having a N_2SA of 70 m^2/g or higher and DBP of 80 ml/100 g or higher (e.g., carbon black of N_2SA = 132 m^2/g and DBP = 100 ml/100 mg; carbon black of N_2SA = 92 m^2/g and DBP = 101 ml/100 mg) (paragraph 0014), which reads on Category (C).

Midorikawa et al does not disclose a heavy tire or silica, however, it teaches that its rubber composition is used in tire treads and that additives normally used in tire compositions are utilized (paragraph 0011).

Sandstrom et al discloses a rubber composition suitable for a passenger tire, aircraft tire, truck tire, and the like (col. 8, lines 8-18), wherein the composition contains diene rubbers like utilized by Midorikawa et al (col. 4, line 60 to col. 5, line 9) and silica added in amounts of 10-20 phr to endeavor to achieve a reduction of rebound values for a rubber composition intended for use as a tire tread (col. 3, line 60 to col. 4, line 3).

Given that Midorikawa et al teaches the use of its rubber composition in a tire tread and is open to conventional additives, it would have been obvious to one of ordinary skill in the art to utilize the rubber composition of Midorikawa et al with silica in any tire tread, including heavy tires like taught by Sandstrom et al, because one of ordinary skill in the art would appreciate that such a composition is useful in any tire tread application based on the teachings by Sandstrom et al regarding identical rubbers.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/27/2006
Vickey Ronesi

Vasu Jagannathan
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